

REMARKS

Claims 1-16 are pending and under consideration. Reconsideration is respectfully requested.

An in-person interview with the Examiner was conducted on March 2, 2004. Applicant thanks the Examiner for the interview. The substance of the interview included discussion of claims 1-16.

ITEM 2: REJECTION OF CLAIMS 1-3, 5-7, 9-11, AND 13-15 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY HIRAYAMA ET AL. (U.S.P. 5,406,307)

Claims 1-3, 5-7, 9-11, and 13-15 are rejected for obviousness over Hirayama et al.

Traverse Of The Rejection

***Prima Facie* Obviousness Not Established**

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 1981, (CCPA 1974).

Calculating A Difference Between Coordinate Values Of Previous And Current Input Operations Not Taught Or Obvious

Independent claims 1, 5, 9, and 13 recite calculating a difference between coordinate values of a previous and a current input operation. The Examiner contends this feature is described by Hirayama citing col. 4, line 65 through col. 5, line 12 and the abstract. (Action at page 2).

Applicant submits that this feature is not described in the cited lines or anywhere else within Hirayama. Hirayama merely describes (See, for example, abstract) touching a window with a point of a pen and dragging the pen along a panel surface. Hirayama further describes (col. 5, lines 1-3) that the "user can visually confirm the exact position of the point of pen 3 on the input tablet 2 very clearly," and describes (col. 5, lines 45-47) "comparing the shifted amount of the pen coordinate with a reference shift amount." However, such a "comparing" does not read on calculating a difference between coordinate values of previous input operations and current input operations.

In addition, while the Examiner contends (Action at page 5) that claims 1 and 5 do not "specifically recite that the difference ... is the difference in distance," it is understood by those in the art that a "calculating" describes more than a mere comparison. For example, the Merriam-Webster Online Dictionary defines calculate as "to determine by mathematical processes." (See Merriam-Webster Online Dictionary at <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=calculate>).

Setting A Coordinate Value As A Coordinate Value Of A Previous Input Operation Not Taught Or Obvious

Claims 1, 5, 9, and 13 recite setting, in the calculating, a coordinate value input at a time when the input means is detached from the surface of the input unit as the coordinate value of the previous input operation.

The Action concedes that Hirayama "does not expressly teach that the coordinate values (are calculated) before and after the input means . . . (are). . . detached." (Action at page 3). However, the Action contends that it would have been obvious:

. . . to realize that the coordinates of the input means . . . (are). . . always stored in the memory so as to be able to update the location of the pen and that can't be accomplished without storing it in a memory.

(Action at page 3).

However, Hirayama et al. does not teach a location of stylus of a pen is stored in memory, as the Examiner contends, but instead only describes (col. 4, lines 19-25):

a tablet interface circuit 31 is formed as one body with the display portion 1 for the input tablet 2 and the pen 3. Data written in the input tablet 2 or the like is supplied to the CPU 21 by means of the tablet interface circuit 31.

Even assuming *arguendo* that the Examiner's contentions concerning what is known to a person of ordinary skill are correct, it is submitted that the features and limitations of the claims are not taught.

Setting Coordinate Value Based On Predetermined Time Not Taught

Independent claim 13 recites setting a coordinate value of a first inputting if a second inputting has not occurred for a predetermined time.

Applicant submits that there is no teaching by Hirayama on any setting based on a "predetermined time." Hirayama only describes (col. 4, lines 5-7) a timer that "outputs data of date and time at each timing point."

Prima Facie Obviousness Not Established For Dependent Claims

Determining An Operation Mode And Setting Based On Determination Result Not Taught

Claims 2, 6, 10, and 14 recite determining an operation mode of an input and enabling or disabling a setting based on a determination result. The Examiner contends that in Hirayama FIG. 4A that when:

the device changes the mode either moving the enlarged icon (step S8) or step S9 whereat the icon is activated (Col. 6, lines 3-21) which fairly reads on the changing of the operation mode.

(Action at page 3).

Applicant submits the Examiner's contention does not apply to operation modes as defined within the present application. As provided in MPEP§2111.01:

when the specification provides definitions for terms appearing in the claims (that) the specification can be used in interpreting claim language. *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

The specification of the present application repeatedly defines operation mode. For example,

two operation modes: an absolute coordinate value mode which outputs the coordinate value of an input point on the coordinate input panel one-to-one on a screen, and a relative coordinate value mode which outputs, as a movement, a difference between the respective coordinate values detected at previous and current sampling timings.

(See pages 1, 2 starting at line 35, emphasis added). Further, Hirayama, only describes (col. 2, lines 5-7) a single coordinate system with:

an icon display coordinate position is moved in accordance with the movement of the position coordinate of the point of the pen.

Determination Based On Contact Area Not Taught

Claims 3, 7, 11, and 15 recite that a determination is "based on a contact area formed by a contact." Hirayama describes only a single contact pen mechanism. There is no description within Hirayama, nor teaching, of any determination based on a size of pen contact area.

Summary

Since *prima facie* obviousness has not been established, the rejections should be withdrawn and claims 1-3, 5-7, 9-11, and 13-15 allowed

ITEM 6: REJECTION OF CLAIMS 4, 8, 12, 16 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY HIRAYAMA ET AL. IN VIEW OF FURUHATA ET AL. (U.S.P. 5,943,043)

Dependent claims 4, 8, 12, and 16 are rejected for obviousness over Hirayama et al. in view of Furuhashi et al. The Action concedes that Hirayama et al. does not teach:

determining the operation mode of the input unit based on a time during which the input means is detached from the surface of the input unit.

(Action at page 5).

However, the Action contends that it would have been obvious:

. . . to make the changing mode of the device based on the time, to be included in the Hirayama's device so as to provide an accurate output based on the user's determination.

(Action at page 4).

No Motivation Or Reasonable Expectation of Success Stated Within the Cited Art To Combine In The Manner Proposed By The Examiner

As provided in MPEP §2143 entitled Basic Requirements of a *Prima Facie* Case of Obviousness:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant submits there is no teaching within Hirayama to change anything, let alone a mode, based on time. Hirayama describes dragging icons with a pen. There is no indication of a manner in which time may be utilized for changing a mode of dragging an icon.

In addition, Applicant submits there is no showing of an incentive or motivation to modify Hirayama et al.'s data processing apparatus "in which information is input by using a pen" (See col. 1, lines 9-10), with teachings of Furuhata et al. directed toward "touch input systems using fingers (that) do not require special devices, such as a pen (See col. 2, lines 48-50)" in a manner suggested by the Examiner or for any other reason.

Summary

Since prima facie obviousness has not been established and there is no incentive to combine the prior art, the rejections should be withdrawn and claims 4, 8, 12, 16 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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